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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,267	05/01/2001	Timothy Merrick Long	169.2039	3091
5514	7590	11/23/2007	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHAMPAGNE, DONALD	
		ART UNIT	PAPER NUMBER	
		3622		
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		11/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/845,267	LONG, TIMOTHY MERRICK
	Examiner Donald L. Champagne	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 October 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 25,29-31 and 37-41 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 25,29-31 and 37-41 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>17 Oct 2007</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.   |

**DETAILED ACTION**

***Rejection Made Non-Final***

1. In accordance with the interview agreement of 17 October 2007 (summary enclosed), the final rejection mailed on 3 October 2007 is hereby made non-final.

***Resumption after Suspension***

2. The suspension of prosecution requested by applicant under 37 CFR 1.103(a) with the RCE filing on 23 October 2006 began with the mailing of the notice of approval on 17 January 2007. The maximum initial period of six months having expired without further request from applicant, prosecution is being continued. See MPEP § 709.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 33351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (US005933811A). Angles et al. teaches an information appliance, comprising:

a display (col. 11 line 64) having a working display area incorporating an ad display area (*advertisement insert 56*, col. 12 lines 51-58 and Fig. 4) disposed within a working display

area (*electronic page 32*), said ad display area being adapted to display advertising information independently of a plurality of different non-advertising applications (an Internet access application, col. 1 lines 45-50 and col. 10 lines 46-50, and an application to activate hyperlinks, col. 2 lines 4-11 and col. 7 lines 27-33) being run on the information appliance (within the non-advertising area of *electronic page 32*), even when any of the plurality of non-advertising applications displays non-advertising information on the working display area (inherently, because, as has been stated, the two displays are independent); and

sending the consumer unique software to allow ads to be merged with content (col. 3 lines 25-28), which inherently reads on input means adapted to accept a software upgrade for a non-advertising application.

6. The following limitation does not add structure to the element it modifies, the input means, and was accordingly not given patentable weight. (Apparatus claims must be structurally distinguishable from the prior art, MPEP § 2114.)

"for a non-advertising application, said software upgrade being configured to update advertising information, wherein said updated advertising information is displayed, independently of the plurality of non-advertising applications being run on the information appliance, even when any of the plurality of non-advertising applications displays non-advertising information on the working display area."

7. Claims 29-31 and 37-41 are rejected under 35 U.S.C. 103(a) as being obvious over Angles et al. in view of Krishan et al. (US006442529B1).
8. Angles et al. does not teach (independent claims 29 and 39) determining a price/price determination means adapted to determine said price dependent upon a difference between said advertising cost and said manufacturing cost. Krishan et al. teaches using advertising revenue to subsidize providing the users with the appliance (*mini-portal device*, col. 4 lines 3-5), which reads on determining a price/price determination means adapted to determine said price dependent upon a difference between said advertising cost and said manufacturing cost. Because Krishan et al. teaches that this would help smaller ISPs remain competitive (col. 1 line 66 to col. 2 line 12), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Krishan et al. to those of Angles et al.

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9. Neither reference teaches (claim 29) appliance selling means and advertising selling means. An ordinary telephone reads on such means. Because it is a well known and useful sales tool, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a telephone/appliance selling means/advertising selling means to the teachings of Krishan et al. and Angles et al.
10. Neither reference explicitly teaches (independent claim 37) means for producing upgrade software. However, since the structure recited in the references is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the reference does teach upgrade software (para. 5 above), so there must inherently be means for producing upgrade software. Neither reference teaches upgrade price determination means, but the logic given in para. 8 above for the appliance also applies to upgrade software. It is common, and necessary, to have advertising cost determination means if one wants to sell advertising, so, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add advertising cost determination means to the teachings of Angles et al. and Krishan et al.
11. Neither reference teaches (claim 31) that advertising cost is dependent on time period of display. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed on 17 October 2005 (para. 17). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)
12. Neither reference teaches (claims 30 and 38) that said price includes a profit. Because a business can be viable only if it makes a profit, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Angles et al. and Krishan et al. that the price of said appliance/upgrade software includes a profit.
13. Neither reference teaches (claims 40 and 41) that the advertising information is pre-loaded before manufacture into the information appliance or loaded after manufacture using an insertable memory medium. Both of these approaches for loading software were well known at the time of the instant invention. Because it is obvious to use the familiar, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to either pre-load advertising information before manufacture into the information appliance or load

said information after manufacture using an insertable memory medium. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed on 17 October 2005 (para. 13 for claims 33 and 34). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

***Response to Arguments***

14. Applicant's arguments filed with an amendment on 26 July 2006 have been fully considered but they are not persuasive.
15. Applicant argues,

"The applied references are not seen to disclose or to suggest the features of independent Claim 25, and in particular, are not seen to disclose or to suggest at least the features of an advertising display area adapted to display advertising information independently of a plurality of different non-advertising applications being run on the information appliance, even when any of the plurality of non-advertising applications displays non-advertising information on a working display area." (Page 8, first para., emphasis added.)

The rejection (para. 5 above) has been revised to explicitly cite a plurality (two) different non-advertising applications.

***Further comment on Patentability***

16. Applicant could claim the combination of software upgrade and advertisement update in such a way as to be a structural limitation to claim 25, but it would not be helpful to patentability. Such a combination is taught by Reilly et al. (col. 8 lines 24-29) and, as also suggested by Reilly et al., it would be obvious to do both together for the sake of convenience.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The

examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

18. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

15 November 2007



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622